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SVT-1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants/Appellants : G. Victor Treyz et al.
Application No. : 09/365,651
Confirmation No. : 2056
Filed : August 2, 1999
For : ON-LINE IMAGE SYSTEM
Group Art Unit : 3625
Examiner : Cuong H. Nguyen

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REPLY BRIEF

Sir:

Appellants are filing this Reply Brief pursuant to 37
C.F.R. § 1.193(b)(1) to respond to the Examiner's Answer dated
June 17, 2004.

The Group 1 Claims (Claims 21-26 and 28-30)

In the Examiner's Answer, the Patent Office focused on
claim 21 as being the broadest claim in Group I.

Claim 21 is directed to an arrangement that allows a user to upload, edit, and print digital images and to select a given type of frame for a print that has been printed.

Claim 21 was rejected under 35 U.S.C. §103(a) based on Oberg in combination with Nozaki.

The Oberg system allows one to preview how certain artwork would appear in various frame moldings.

In the Appeal Brief, Appellants pointed out that the Oberg system does not disclose digital printing equipment that is configured to print an edited digital image to create a print for framing as required by claim 21.

In the Examiner's Answer, this basic point was not rebutted. The Examiner's Answer does not and cannot identify anything in Oberg where a digital image is printed for framing.

Nozaki relates to a system for generating sound images and does nothing to make up for the failure of Oberg's system to print a digital image for framing. The Nozaki "frames" are not ordinary physical picture frames for hanging on a wall, but are graphic constructs that are used as templates. (See, for example, column 13, lines 32-34, where Nozaki explicitly defines the term "frame" as meaning the "image recording region" in which an image is recorded.) Appellants made it clear that Nozaki failed to disclose picture frames in the Appeal Brief, and the Examiner's Answer has not attempted to rebut this point.

Claim 21 and the other claims of Group I are therefore patentable for the basic reason that Oberg and Nozaki (whether taken alone or in combination) fail to disclose digital printing equipment that is configured to print an edited digital image to create a print for framing as required by claim 21.

The Examiner's Answer also fails, as did the Office Action, to provide any prior art motivation for combining the cited references under §103. In attempting to provide the required prior art motivation for the §103 combination of Oberg and Nozaki, the Examiner's Answer states that "all of the above-cited references were in the same specific application of digital images for picture-ordering online." This statement is incorrect, because Oberg does not relate to digital images for picture-ordering online. Moreover, the mere fact that two prior art references both relate to the same field is not sufficient prior art motivation for combining those references for the purposes of 35 U.S.C. §103.

The Group 2 Claim (claim 27)

In the August 25, 2003 Office Action, the Group 2 claim (claim 27) was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Oberg and Nozaki or the combination of Oberg and Weisman.

Claim 27 is directed to ordering albums of different

materials. In the Office Action, reference was made to Oberg's abstract in rejecting claim 27. However, as Appellants made clear in their Appeal Brief, the Oberg abstract makes no mention of albums of different materials or the ordering of albums of different materials. This is because Oberg's system is directed to computerized previewing of artwork in a store, not the on-line selection of albums.

In the Examiner's Answer, it is stated Oberg's computer "is configured to provide the user with an on-line opportunity to order albums of different materials" (citing Oberg's Abstract, and column 3, lines 7-11 and 25-53 of Oberg). This statement is false.

Oberg's abstract makes no mention of albums, let alone albums of different materials or on-line ordering of albums of different materials. Rather, Oberg's abstract describes the Oberg system with which a user can preview artwork in combination with various frame moldings and matting material combinations. Albums are not mentioned anywhere. The purportedly relevant passage at column 3, lines 7-11 states that "Another object is to produce a visual display of an object to be framed in order to coordinate the dimensions and color characteristics of the frame to the object to be framed without having to handle the framing or matting material before the selection can be made." This passage makes no mention of

albums. The purportedly relevant passage at column 3, lines 25-53 states "The present invention comprises a computerized system that provides means for developing a digital image of an object such as an object of artwork supplied by the user, analyzing the color composition of the image, searching a database for coordinating frame and matting material products, developing composite images of the user's input with the matching selections, and presenting the digital images to the user so the items may be previewed before placing an order." This passage also makes no mention of albums.

Accordingly, none of the passages cited in the Examiner's Answer support the position taken in the Examiner's Answer that Oberg "is configured to provide the user with an on-line opportunity to order albums of different materials."

The Examiner's Answer also states that "It would be obvious for one with ordinary skill in the art to implement Oberg's ideas with Nozaki et al.'s suggestion to order frames of different colors and to order albums of different materials because they operate online prints-order businesses." This statement implies that Nozaki discloses the ordering of albums of different materials. However, Nozaki makes no mention of albums, let alone the ordering of albums of different materials.

Appellants' position on claim 27 is that Oberg fails to disclose the online ordering of albums of different materials

and that Nozaki fails to disclose the online ordering of albums of different materials. Both references fail to disclose albums. In the Examiner's Answer, a number of statements were made to try to counter this point, but, as clearly shown above, the portions of Oberg and Nozaki that were relied upon in the Examiner's Answer are not relevant and make no mention of albums.

The Group 3 claim (claim 31)

Claim 31 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Oberg and Nozaki or the combination of Oberg and Weisman.

Claim 31 is directed to using email messages that include URLs that allow recipients to view and order prints through a web browser. Claim 31 was rejected with reference to Weisman and Oberg's summary. However, neither Weisman or Oberg disclose email messages that include URLs that allow a message recipient to view and order prints through a web browser.

In addressing these shortcomings of Weisman and Oberg in the Office Action (page 2, item 3C), it was stated that "one with ordinary skill in the art would recognize that an email message may include a service provider's URL; because an email would contain many different things" and that one of these things "can be a service provider's website because this create

a convenience for email receiver who likes to communicate with said service provider."

As Appellants made clear in their Appeal Brief, this is not sufficient for a §103 rejection. A §103 rejection must be based on the prior art, not hindsight reconstruction based on Appellants' own invention. Even though an email might contain different things, it does not follow that prior art emails included Appellants' claimed URLs as intimated in the Office Action. There is simply nothing in the Oberg, Weisman, or Nozaki cited prior art to suggest providing email messages containing URLs to message recipients so that the recipients can view and order prints through a web browser as set forth in claim 31.

In the Examiner's Answer, it was conceded that Nozaki and Oberg do not expressly disclose that their computers are configured to email a message to a party other than the user over the Internet that includes a URL that allows the party to view and order prints. However, it was urged that page 1 of Weisman's article "teaches this limitation by 'forwarding' a message in the Internet." The only passage on page 1 of Weisman that mentions "forwarding" states:

"Maybe you have been a member of a wedding recently. Maybe there was a professional photographer who carefully posed

everyone, then mailed off proofs of the pictures who forwarded them to one person, who forwarded them to another, who forwarded them to a third. And maybe you waited for final pictures of the happy day."

This passage is plainly describing the process of mailing of wedding proofs from person to person through the regular mail, not by email through the Internet. The cited passage therefore does not even disclose the emailing of images, let alone the emailing of URLs that allow parties to view and order prints.

Claim 31 is therefore patentable over Oberg, Weisman, and Nozaki.

The Group 4 claim (claim 32)

In the August 25, 2003 Office Action, claim 32 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Oberg and Nozaki or the combination of Oberg and Weisman.

Claim 32 is directed to ordering prints that include the user as a subject and that include a background different than the background against which the user was originally photographed. The actual background of the print itself is different. (See, for example, the patent application

description of how images may be manipulated to select a background containing the image of a cartoon character or an actor at page 5, lines 6-10.)

Claim 32 was rejected primarily with reference to Weisman. Weisman mentions backgrounds, but they are not the type of backgrounds that are inside a picture. Rather, Weisman's "backgrounds" are the colors of the web pages on which the Memories Online web site displays clients' images. Because the Memories Online web page colors are not part of the image, Weisman does not disclose the feature of claim 32 wherein the user can order prints that include both the user as a subject and a background different than the background against which the user was originally photographed. The Memories Online background colors do not take the place of the background against which the user was originally photographed.

In the Examiner's Answer, no effort was made to explain how changing a web page background color for an online album could be equated with changing the actual background of a picture to allow the ordering of prints that include the user as a subject and that include a background different than the background against which the user was originally photographed. Appellants' Appeal Brief arguments regarding claim 32 have therefore not been rebutted.

The final point made in the Examiner's Answer in

discussing claim 32 is as follows:

"One of ordinary skill in the art would combine Oberg, Nozaki, and Weisman because artisans recognize that an identity for a person, a location (e.g., a URL), a different background have been necessary to specify in ordering because this is very convenient and easy to do with a popular trend of computerized communications between different parties."

This passage also fails to point to anything in Oberg, Nozaki, or Weisman that discloses or suggests the replacement of the background of a print to include the user as a subject against a background different than the background against which the user was originally photographed.

The Group 5 claims (claims 33, 35-37, and 40)

Independent claim 33 relates to event photography. In particular, claim 33 is directed toward order servicing equipment that allows users to place on-line orders for prints of digital images taken by a photographer at an event. As set forth in claim 33, the order servicing equipment comprises an order servicing computer that is provided with a customer list and that uses an assignment title to identify the event. The order servicing computer uses the customer information in providing customers with an opportunity to place an on-line order for a print. Dependent claim 40 is directed to an

arrangement in which the order servicing computer is configured to provide the digital images to a processing lab in a different city than the order servicing computer for printing.

Nothing in Oberg, Weisman, and Nozaki relates to on-line systems for event photography having the customer list and assignment title features of claim 33 (or claim 40).

In the Office Action, the shortcomings of Oberg, Weisman, and Nozaki with respect to event photography were addressed by stating that the "claimed language 'customer list' and 'title' in a provider's database are old and well-known in the art." (Office Action, page 2, item 3E)

However, as Appellants pointed out in their Appeal Brief, it doesn't follow that because a customer list or a title is "old," that it would be obvious to produce order servicing equipment that allows users to place on-line orders for prints of digital images taken by a photographer at an event that has an order servicing computer that is provided with a customer list and that uses an assignment title to identify the event. The shortcomings of Oberg, Weisman, and Nozaki that Appellants have identified with respect to computerized on-line event photography are not made up for by the fact that customer lists and titles are old, so claim 33 and dependent claims 35-37 and 40 are patentable.

In the Examiner's Answer, the Patent Office did not

attempt to rebut Appellants' basic Appeal Brief arguments with respect to independent claim 33, but rather attacked dependent claim 40, stating that "This 'system' claim contains similar features as in system claim 21 and 38 because of Internet capability in communications is a fact, where sending, receiving, and printing computers can be in different cities." The Examiner's Answer then went on to state "One of ordinary skill in the art would recognize that Internet is used to communicate anywhere in the globe. Therefore a combination of Oberg, and Nozaki et al. to order prints on the Internet would be obvious to claim 40 subject matter." These statements miss the mark because they do not address the use of the customer list and assignment title to identity the event, as required by the independent claim 33 and dependent claims 35-37 and 40.

The claims of Group 5 are therefore patentable. The Examiner's Answer has failed to rebut the arguments made in the Appeal Brief that distinguished Appellants' on-line systems for event photography having the customer list and assignment title features of claim 33 from the systems of Oberg, Weisman, and Nozaki (which make no mention of these features). The dependent claim feature of claim 40 that was discussed in the Examiner's Answer stands or falls with claim 33 for purposes of this appeal.

The Group 6 claims (Claims 34 and 39)

In the August 25, 2003 Office Action, claims 34 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Oberg and Nozaki or the combination of Oberg and Weisman.

As Appellants made clear in their Appeal Brief, claims 34 and 39 are directed to arrangements in which customers are originally photographed against a solid background. The resulting digital image is then manipulated to replace the solid color background with a new background. The Oberg, Weisman, and Nozaki references do not disclose this feature. The "backgrounds" of Weisman that were relied upon in rejecting these claims are just the colors of the web pages on which the Memories Online website displays images and do not replace any existing solid backgrounds against which customers were originally photographed.

The Examiner's Answer does not address the points raised in the Appeal Brief. Even though Appellants described how the Weisman "backgrounds" do not replace solid backgrounds against which customers were originally photographed, the Examiner's Answer continues to rely on the Weisman article (page 2, describing the Memories Online "backgrounds"). Appellants' Appeal Brief arguments for the patentability of the Group 6 claims have therefore not been rebutted.

The second paragraph of the discussion in the Examiner's Answer is apparently an attempt to combine the Oberg, Nozaki, and Weisman references. However, background replacement is not mentioned in any of these references and this paragraph of the Examiner's Answer makes no attempt at explaining how a combination of Oberg, Nozaki, and Weisman would disclose the claimed background replacement feature. Even if it were proper to combine these references, the combination would still fail to disclose the arrangement of the Group 6 claims in which customers are originally photographed against a solid background to produce a digital image that is then manipulated to replace the solid color background with a new background.

Claims 34 and 39 are therefore patentable over Oberg, Weisman, and Nozaki.

The Group 7 Claim (claim 38)

Claim 38 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Oberg and Nozaki or the combination of Oberg and Weisman.

Claim 38 relates to ordering wood and metal framed prints of images taken by a photographer at an event. Nothing in the Oberg, Weisman, or Nozaki references describes the ordering of wood or metal framed prints, let alone the ordering of wood or metal framed prints of images taken by a photographer

at an event.

In item 3G of the final Office Action it is implied that claim 38 is not patentable because wood frames are old. However, as Appellants made clear in their Appeal Brief, it simply does not follow that the arrangement of claim 38 that allows the ordering of wood and metal framed prints of images taken by the photographer at an event is unpatentable because wood frames are old. The fact that wood frames are old does not make up for the deficiencies in the Oberg, Weisman, and Nozaki references.

In the Examiner's Answer, it is stated without any prior art support or reasoning that claim 38 is obvious. No attempt is made to rebut the arguments made by Appellants in their Appeal Brief.

Because nothing in the Oberg, Weisman, or Nozaki references describes the ordering of wood or metal framed prints of images taken by a photographer at an event, claim 38 is patentable.

Comments on the "Notes" at the End of the Examiner's Answer

In a section labeled "NOTES", the Examiner's Answer makes some observations that are addressed in this section.

The Examiner states that prior art software exists for cropping images. This statement does not appear pertinent to

the claimed invention, but in any event Appellants agree that PC-based image editing software has existed prior to the invention.

In part A, the Examiner states that Appellants' earlier statement that "Oberg's system can generate order copies, not prints to be framed" is incorrect. Appellants stand by their original position. Oberg's system cannot generate prints to be framed. Apparently the Examiner is speculating about a modified Oberg system in which different software and control functions have been incorporated into Oberg's computer system to provide the functionality desired by the Examiner. Such hindsight modification of Oberg based on Appellants' application is not proper and cannot be used to reject Appellants' claims under 35 U.S.C. §103. Appellants' original statement was correct. Oberg's system generates order copies, but not prints to be framed.

The Examiner also argues that it would be obvious to modify Oberg to provide printing of prints to be framed. Appellants disagree. As pointed out previously, Oberg's system is used to assist a customer with original artwork who wishes to preview how the original artwork would look in a particular frame. A customer would desire to mount the original artwork, not a copy. A modification to Oberg so that the system would need to copy and reproduce the customer's original artwork is

not only not disclosed or suggested in Oberg, but is pointless and counterproductive. Copying and printing the customer's original artwork using Oberg's system adds a needless step and needless expense. Moreover, the customer would be left with a copy of the artwork rather than the original.

In section B, the Examiner's Answer restates the argument made in the Office Action in connection with claim 27 (the Group 2 claim related to ordering albums of different materials). In that argument, it was stated that "a selection from user would imply that there are different materials to choose" (citing the Oberg Abstract). It was also stated that Oberg "does not necessarily spell-out similar languages because one with ordinary skill in the art would know and understand about the equivalent (although different) meanings of this invention." (Office Action, page 1).

As Appellants have maintained throughout the prosecution of this application, Oberg's abstract makes no mention of albums of different materials or the ordering of albums of different materials. The reason Oberg does not "spell-out" anything to do with albums is because Oberg's system is directed to a different endeavor -- namely the computerized previewing of artwork in a store, not the on-line selection of albums. There is nothing in Oberg that even suggests that the Oberg artwork would be suitable to fit in an album in the first

place.

The Oberg system clearly relates to artwork to be framed, not artwork to be placed in an album. Because claim 27 explicitly requires the ordering of albums of different materials, whereas Oberg does not show or suggest albums of any sort, claim 27 is patentable.

In section C, the Examiner's Answer addresses the Group 3 claim (claim 31), which is directed to using email messages that include URLs that allow recipients to view and order prints through a web browser. In section C, the Examiner's Answer states that one with ordinary skill in the art would recognize that an email message may include may different things. As Appellants explained above, however, this observation by itself is not sufficient to sustain a prior art rejection of claim 31.

In section D, the Examiner's answer takes issue with the language "background" of claim 32 as being "non-functional descriptive material." Appellants believe that the term "background" helps to define the invention. The background of an image of a user is the portion of the image that resides behind the user and is a well-understood concept in photography. Appellants are not claiming a particular background color as intimated in the Examiner's Answer.

In section E, the Examiner's Answer states that some

of the claim language of claim 33 -- i.e., the terms "customer list" and "title" are well known. Appellants agree that these terms are well known. The Examiner's Answer also states that "It is not inventive for a claimed system that having these features." Appellants disagree. The fact that isolated terms in a claim have an existing meaning in a particular art area does not allow one to draw conclusions about the patentability of that claim. All of the elements of the claim must be considered in a determination of patentability.

In section F, the Examiner's Answer addresses claims 34 and 39 (the Group 6 claims). In particular, the Examiner's Answer states that "the claimed apparatus is reasonable interpreted by physical structures that making up that apparatus". No new prior art argument or statutory rejection is made in this section, which Appellants understand is attempting to support the rejection of claims 34 and 39. Appellants' position with respect to claims 34 and 39 is provided above in the discussion of the Group 6 claims.

In section G, the Examiner's Answer states that the apparatus of claim 38 (the Group 7 claim) "has old and well-known limitation" and that "wood framed prints are old and well-known features." Appellants agree that wood-framed prints are well known, but disagrees with respect to the Examiner's conclusions about claim 38. See Appellants' discussion of the

Group 7 claim above.

In section H, the Examiner's Answer states that "The examiner considers claiming particular information are non-functional descriptive material." However, the Examiner's Answer does not attempt to apply this reasoning to any claims in the application nor does the Examiner's Answer identify any claims where patentability rests solely on the claiming of "particular information."

In Section I, the Examiner's Answer urges that the prior art renders Appellants' claims unpatentable. Appellants disagree for the reasons stated above.

In section J, the Examiner's Answer states that claims 21, 33, and 38 are directed to what the claimed equipment "is" rather than what it "does." No statutory rejections or objections are made.

Conclusion

The Examiner's Answer has failed to rebut Appellants' Appeal Brief arguments. Claims 21-40 are therefore in condition

for allowance. The Examiner's rejections of these claims should be reversed.

Respectfully submitted,

8/16/04

Date

G. Victor Treyz

G. Victor Treyz

Reg. No. 36,294

Attorney for Applicants/Appellants

Customer No. 36532